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09/903,836	07/11/2001	Richard E. Fangman	5686-00400	2191

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EXAMINER

LEE, ANDREW CHUNG CHEUNG

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary	Application No. 09/903,836	Applicant(s) FANGMAN ET AL.	
	Examiner Andrew C Lee	Art Unit 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 9, 15-24, 31- 40, 46 is/are rejected.
- 7) ☒ Claim(s) 10-14, 25-30 and 41-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>Mar 12, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 – 9, 15 – 24, 31– 40, 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 11, 49, , 21, 44 and 62 of U.S. Patent No. 6687245 B2.

Regarding claim 1, *a method of performing IP telephone (see U.S. Patent No. 6687245 B2, column 33, line 1) receiving a data packet from an IP telephone, wherein the data packet comprises a private source IP address, a source port number, and destination information associated with an IP device; performing a network address persistent port translation (NAPPT) on the data packet; and sending the data packet to the IP device. (see U.S. Patent No. 6687245 B2, column 33, lines 17 – 25).*

Regarding claim 2, *the method of claim 1, wherein said performing a network address persistent port translation (NAPPT) on the data packet comprises changing the private source IP address to a public source IP address while leaving the source port number unchanged, and wherein the public source IP address and the source port number may be used to uniquely identify the IP telephone. (see U.S. Patent No. 6687245 B2, column 33, lines 42 – 48).*

Regarding claim 3, *the method of claim 1, further comprising: receiving a data packet from the IP device, wherein the data packet comprises a public destination IP address, a destination port number, and source information, wherein said public destination IP address comprises said public source IP address, and wherein said destination port number comprises said source port number; performing a network address persistent port translation (NAPPT) on the data packet received from the IP device; and sending the data packet received from the IP device to the IP telephone*

(see U.S. Patent No. 6687245 B2, column 39, lines 56 – 60, 63 – 65).

Regarding claim 4, *the method of claim 3, wherein said performing a network address persistent port translation (NAPPT) on the data packet received from the destination comprises using the public destination IP address and the destination port number to uniquely identify the IP telephone, and changing the public destination IP address to the private source IP address while leaving the destination port number unchanged* (see U.S. Patent No. 6687245 B2, column 40, lines 3 – 10).

Regarding claims 5, 20, 36, *the method of claim 3, wherein said source port number and said destination port number are in an assigned range of port numbers comprising ports which are not reserved for use by other IP protocols* (see U.S. Patent No. 6687245 B2, column 36, lines 52 – 54).

Regarding claim 6, *the method of claim 1, further comprising performing the following steps prior to said receiving said packet: receiving an identifier from the IP telephone; determining if the identifier is valid; and if the identifier is valid, assigning a range of port numbers to the IP telephone based on the identifier, wherein the IP telephone is operable to use at least a subset of the range of port numbers to send or receive IP communications* (see U.S. Patent No. 6687245 B2, column 33, lines 26 – 34).

Regarding claim 7, *the method of claim 6, wherein said range of port numbers comprises ports which are not reserved for use by other IP protocols (see U.S. Patent No. 6687245 B2, column 36, lines 52 – 54).*

Regarding claim 8, *the method of claim 6, wherein the identifier comprises a vendor class identifier (see U.S. Patent No. 6687245 B2, column 33, lines 35 – 36).*

Regarding claim 9, *the method of claim 6, wherein said determining comprises: determining if a MAC ID for the IP telephone is valid; and if the MAC ID is determined to be valid, then determining if the identifier is valid (see U.S. Patent No. 6687245 B2, column 33, lines 37 – 41).*

Regarding claim 15, *the method of claim 6, wherein the range of port numbers comprises one or more port numbers (see U.S. Patent No. 6687245 B2, column 33, lines 7 – 8).*

Regarding claim 16, *a system for performing IP telephony, comprising: a network; an IP telephone; a Service Gateway, wherein the Service Gateway is operable to couple to the IP telephone through the network; wherein the Service Gateway is further operable to: receive a data packet from an IP telephone, wherein the data packet comprises a private source IP address, a source port number, and destination information associated with an IP device; perform a network address persistent port*

translation (NAPPT) on the data packet; and send the data packet to the IP device (see U.S. Patent No. 6687245 B2, column 35, lines 61 – 65; column 36, lines 20 – 28).

Regarding claim 17, the system of claim 16, wherein, in performing a network address persistent port translation (NAPPT) on the data packet, the Service Gateway is operable to: change the private source IP address to a public source IP address while leaving the source port number unchanged, and wherein the public source IP address and the source port number may be used to uniquely identify the IP telephone (see U.S. Patent No. 6687245 B2, column 36, lines 29 – 35).

Regarding claim 18, the system of claim 16, wherein the Service Gateway is further operable to: receive a data packet from the IP device, wherein the data packet comprises a public destination IP address, a destination port number, and source information, wherein said public destination IP address comprises said public source IP address, and wherein said destination port number comprises said source port number; perform a network address persistent port translation (NAPPT) on the data packet received from the IP device; and send the data packet received from the IP device to the IP telephone (see U.S. Patent No. 6687245 B2, column 39, lines 56 – 60; lines 63 – 65).

Regarding claim 19, the system of claim 18, wherein, in performing a network address persistent port translation (NAPPT) on the data packet received from the IP

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device, the Service Gateway is operable to: use the public destination IP address and the destination port number to uniquely identify the IP telephone; and change the public destination IP address to the private source IP address while leaving the destination port number unchanged (see U.S. Patent No. 6687245 B2, column 40, lines 3 – 10).

Regarding claim 20, the system of claim 18, wherein said source port number and said destination port number are in an assigned range of port numbers comprising ports which are not reserved for use by other IP protocols.

Regarding claim 21, *the system of claim 16, wherein, prior to said receiving said packet, the Service Gateway is further operable to: receive an identifier from the IP telephone; determine if the identifier is valid; and if the identifier is valid, assign a range of port numbers to the IP telephone based on the identifier, wherein the IP telephone is operable to use at least a subset of the range of port numbers to send or receive IP communications (see U.S. Patent No. 6687245 B2, column 36, lines 36 – 44).*

Regarding claim 22, *the system of claim 21, wherein said range of port numbers comprises ports which are not reserved for use by other IP protocols (see U.S. Patent No. 6687245 B2, column 36, lines 52 – 54).*

Regarding claim 23, *the system of claim 21, wherein the identifier comprises a vendor class identifier (see U.S. Patent No. 6687245 B2, column 36, lines 45 – 46).*

Regarding claim 24, *the system of claim 21, wherein, in determining if the identifier is valid, the Service Gateway is operable to: determine if a MAC ID for the IP telephone is valid; and if the MAC ID is determined to be valid, then determine if the identifier is valid (see U.S. Patent No. 6687245 B2, column 36, lines 47 – 51).*

Regarding claim 31, *the system of claim 21, wherein the range of port numbers comprises one or more port numbers (see U.S. Patent No. 6687245 B2, column 33, lines 7 – 8).*

Regarding claim 32, *a memory medium, wherein the memory medium is operable to store program instructions which are executable to perform (see U.S. Patent No. 6687245 B2, column 39, lines 19 – 21; column 43, lines 4 – 6): receiving a data packet from an IP telephone, wherein the data packet comprises a private source IP address, a source port number, and destination information associated with an IP device; performing a network address persistent port translation (NAPPT) on the data packet; and sending the data packet to the IP device (see U.S. Patent No. 6687245 B2, column 39, lines 33 – 36; lines 39 – 41).*

Regarding claim 33, *the memory medium of claim 32, wherein said performing a network address persistent port translation (NAPPT) on the data packet comprises changing the private source IP address to a public source IP address while leaving the source port number unchanged, and wherein the public source IP address and the source port number may be used to uniquely identify the IP telephone (see U.S. Patent No. 6687245 B2, column 39, lines 46 – 52).*

Regarding claim 34, *the memory medium of claim 32, wherein the program instructions are further executable to perform: receiving a data packet from the IP device, wherein the data packet comprises a public destination IP address, a destination port number, and source information, wherein said public destination IP address comprises said public source IP address, and wherein said destination port number comprises said source port number; performing a network address persistent port translation (NAPPT) on the data packet received from the IP device; and sending the data packet received from the IP device to the IP telephone (see U.S. Patent No. 6687245 B2, column 39, lines 56 – 60; lines 63 – 65).*

Regarding claim 35, *the memory medium of claim 34, wherein said performing a network address persistent port translation (NAPPT) on the data packet received from the destination comprises using the public destination IP address and the destination port number to uniquely identify the IP telephone, and changing the public destination IP*

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address to the private source IP address while leaving the destination port number unchanged (see U.S. Patent No. 6687245 B2, column 40, lines 3 – 10).

Regarding claim 37, the memory medium of claim 32, wherein the program instructions are further executable to perform the following steps prior to said receiving said packet: receiving an identifier from the IP telephone; determining if the identifier is valid; and if the identifier is valid, assigning a range of port numbers to the IP telephone based on the identifier, wherein the IP telephone is operable to use at least a subset of the range of port numbers to send or receive IP communications (see U.S. Patent No. 6687245 B2, column 40, lines 11 – 20).

Regarding claim 38, the memory medium of claim 37, wherein said range of port numbers comprises ports which are not reserved for use by other IP protocols (see U.S. Patent No. 6687245 B2, column 36, lines 52 – 54).

Regarding claim 39, the memory medium of claim 37, wherein the identifier comprises a vendor class identifier (see U.S. Patent No. 6687245 B2, column 40, lines 25 – 26).

Regarding claim 40, the memory medium of claim 37, wherein said determining comprises: determining if a MAC ID for the IP telephone is valid; and if the MAC ID is

determined to be valid, then determining if the identifier is valid (see U.S. Patent No. 6687245 B2, column 40, lines 27 – 31).

Regarding claim 46, the memory medium of claim 37, wherein the range of port numbers comprises one or more port numbers (see U.S. Patent No. 6687245 B2, column 33, lines 7 – 8).

3. For claim 1, Applicant merely broadens the scope of U.S. Patent No. 6687245 B2 claim 7 by eliminating the reference terms — “with an IP telephone”, “activating the IP telephone; performing client DHCP lease negotiation with the IP telephone, wherein an identifier of the telephone is used to determine a range of port numbers assigned to the IP telephone, wherein the range of ports numbers comprises one or more port numbers which are not reserved for use by other IP protocols; initializing the TIP telephone; registering the IP telephone; and performing IP communications using the IP telephone; wherein said performing IP communications uses one or more ports in the range of assigned ports, and wherein said performing IP communications using IP telephone comprises:”

For claims 2, 17, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 11.

For claims 3, 18, Applicant merely broadens the scope of U.S. Patent No. 6687245 B2 claim 47 by eliminating the reference terms — “The memory medium of claim 44, wherein said performing IP communications using the IP telephone comprises:”, and by minor modifying the reference term” wherein said destination ports

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number is in the assigned range of port numbers and wherein the public destination IP address and the destination port number may be used to uniquely identify the IP telephone " with "wherein said public destination IP address comprises said public source IP address, and wherein said destination port number comprises said source port number", by eliminating the reference terms "l)", and "j)".

For claims 4, 19, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 49.

For claims 5, 20, 36, Applicant merely specifies the scope of U.S. Patent No. 6687245 B2 claim 26 by replacing reference terms — "the" with "said source port number and said destination port number are in an assigned", and by eliminating the reference terms "one or more" and "numbers".

For claims 6, 21, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 8.

For claims 7, 22, 38, Applicant merely broadens the scope of U.S. Patent No. 6687245 B2 claim 26 by replacing reference terms — "the" with "said", and by eliminating the reference terms "one or more" and "numbers".

For claims 8, 23, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 9.

For claims 9, 24, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 10.

For claims 15, 31, 46, Applicant merely extracts a phrase (lines 7 –8) from the scope of U.S. Patent No. 6687245 B2 claim 7.

For claim 32, Applicant merely broadens the scope of U.S. Patent No. 6687245 B2 claim 44 by eliminating the reference terms — “a) performing client DHCP lease negotiation with the IP telephone, wherein an identifier of the IP telephone is used to determine a range of port numbers assigned to the IP telephone; b) initializing the IP telephone; e) registering the IP telephone; and d) performing IP communications using the IP telephone; wherein said performing IP communications uses one or more ports in the range of assigned ports, and wherein said performing IP communications using IP telephone comprises:”

For claim 33, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 46.

For claim 34, Applicant merely broadens the scope of U.S. Patent No. 6687245 B2 claim 44 by eliminating the reference terms — “said performing Ip communications using the IP telephone comprises:” and “ and “h)”, “wherein the public destination IP address and the destination port number may be used to uniquely identify the IP telephone “, “l)”, “j)”.

For claim 35, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 49.

For claim 37, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 50.

For claim 38, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 26.

For claim 39, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 52.

For claim 40, Applicant merely copies the scope of U.S. Patent No. 6687245 B2 claim 53.

It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969) ; omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Allowable Subject Matter

4. Claims 10 –14, 25 – 30, 41 – 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (703) 305-8086 whose telephone number is (703) 305-

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8086. The examiner can normally be reached on Monday through Friday from 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (703) 305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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07 Jan 2005


AJP Patel
Primary Examiner